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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/849,404    05/22/97    LAFFEND    L    CR-9715-B

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LEGAL PATENTS  
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HM22/0828

EXAMINER

BUGAISKY, G

ART UNIT	PAPER NUMBER
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1653

25

DATE MAILED:

08/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/849,404**

Applicant(s)  
**Laffend et al.**

Examiner  
**Gabriele E. Bugalsky**

Group Art Unit  
**1653**



☒ Responsive to communication(s) filed on May 24, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 20-30 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 20-30 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

The amendment of 5/200 is acknowledged. Claims 20-30 remain pending.

#### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 22 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 of prior U.S. Patent No. 6025184. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 20-21 and 22-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 4 of U.S. Patent No. 6025184. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in each are directed to constructs containing a 35 kb DNA fragment comprising the *dha* regulon of *Klebsiella pneumoniae*. With respect to the specific deposited strains of claims 24-30, it is noted that the patent includes any host bacterium comprising the 35 kb fragment and it is suggested (Column 10, lines 56-67 and column 11, lines 1-9) that other specific hosts can be used.

The newly presented grounds of rejection based upon double patenting will not preclude the finality of this Office action. Indeed, these grounds of rejection involve conflicting claims newly discovered by the Examiner, all of which have the same inventive entity, assignee and attorney, and Applicants did not call the attention of the Office to the copending application(s). Applicants will not be permitted to extend the prosecution of the present application by reason of their inaction with regard to notice to the Office of conflicting claims in copending applications, the discovery of which necessitated the new grounds of rejection at this advanced point in the prosecution. Indeed, with appropriate notice, these grounds of rejection clearly could have been incorporated in a prior Office action. This situation is clearly analogous to the policy of making an action final where applicant's material amendments to the claims necessitated a new ground of

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rejection, since in both instances it is applicant who caused the rejection to be applied after the case had received an action on the merits. See MPEP Section 706.07(a).

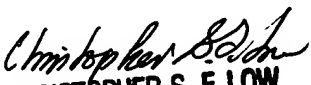
No claims are allowed.


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Gabriele E. Bugaisky, Ph.D. whose telephone number is (703) 308-4201. The Examiner can normally be reached from 7:30 AM to 1:30 PM on weekdays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher S. F. Low, can be reached at (703) 308-2923.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center number is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

  
geb  
August 25, 2000